

U.S. Application No. 10/691,352, filed October 22, 2003  
Attorney Docket No. 14231US02  
Amendment dated January 31, 2008  
In Response to Office Action mailed October 31, 2007

### REMARKS

Claims 44-94 are pending. Claims 44-49, 54-58, 67-86 and 91-94 stand rejected. Claims 49-53, 59-66 and 87-90 are allowed.

Applicants cancel, without prejudice, claims 44-49, 54-58, 67-86 and 91-94. Applicants respectfully reserve the right to pursue the subject matter recited in any of the cancelled claims in a continuing or related application.

Applicant gratefully acknowledges the indication by the Examiner that claims 49-53, 59-66 and 87-90 are allowed.

Claims 49, 59 and 87 have been amended. It is believed that claims 49-53, 59-66 and 87-90 are still in condition for allowance.

Applicants have added new claims 95-110 that depend from the already allowed claims. It is believed that the newly added claims 95-110 are in condition for allowance. It is also believed that no additional claims fees are required.

Although claim 44-49, 54-58, 67-86 and 91-94 have been cancelled, Applicants respectfully address some of the issues raised by the Examiner.

With respect to claims 46, 56, 69, 74, 79 and 84, the Examiner alleges that Trahan teaches a user interface comprising an alphanumeric keypad. Applicants respectfully disagree and note that Trahan does not even mention an alphanumeric keypad. It is pointed out that whether Trahan teaches or does not teach elements as set forth in the claims is improper under an anticipation rejection.

Applicants respectfully challenge the assertion that the elements in claims 46, 56, 69, 74, 79 and 84 are all inherent. Applicants believe that the Examiner is improperly applying the

doctrine of inherency.

A patent law treatise by Donald S. Chisum states that “Federal Circuit decisions emphasize that an anticipatory inherent feature or result must be consistent, necessary, and inevitable, not merely possible.” Chisum on Patents § 3.03[2][b] (December 2004).

The United States Court of Appeals for the Federal Circuit (“the Federal Circuit”) has stated that “anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation”. *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1373, 62 U.S.P.Q. 2d 1865 (Fed. Cir. 2002).

The Federal Circuit has also stated that “[i]nherency does not embrace probabilities or possibilities” and that “[i]nherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1297, 63 U.S.P.Q. 2d 1597 (Fed. Cir. 2002).

Although the rejection of claims 44, 54, 67, 72, 77, 82 and 91 include the phrase “inherently”, it is not clear whether the Examiner is applying the inherency doctrine. Further clarification would be helpful in order for Applicants to fully address the Examiner’s allegations. As it is worded, it appears that the Examiner is alleging that a computerized system inherently contains some form of a microprocessor or processor such as an internal data processing device. As stated above, since not all computerized systems necessarily have internal data processing devices. It is possible, for example, that a computerize system could have an external data processing device or a different type of processing device. Accordingly, Applicants respectfully challenge the use of the inherency doctrine as set forth in the Office Action.

With respect to claim 93, the Examiner alleges, without any supporting evidence, that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to include alpha characters on the interface, in order to expand the writing capabilities of the interface (111), by allowing a user to send a message”. Office Action at pages 8 and 9.

Applicant respectfully challenges the conclusory assertions made in the Office Action

without any supporting evidence that the elements recited in claim 93 are well known or obvious in the art. Applicant respectfully submits that the elements recited in claim 93 are not well known or obvious in their respective contexts. Applicant respectfully submits that, for example, in the context of the elements as recited in independent claim 91, the elements in dependent claim 93 are not well known or obvious. Furthermore, the Examiner appears to be alleging that alphanumeric keypads are obvious because wireless text messaging was well known at the time of Trahan and Schaefer. See Office Action at page 9. The Examiner needs to back up such extraordinary assertions with documentary evidence showing that wireless text messaging was well known in the art, since apparently wireless text messaging is the Examiner's rationale for asserting alphanumeric keypads as obvious.

M.P.E.P. § 2144.03(E) states that "[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based." Accordingly, in order to maintain the rejection, Applicants respectfully request that the Examiner produce references in support of the Examiner's contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, then the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2).

Applicants respectfully submit that the elements recited in the claims may be probable or possible elements, but are not necessary elements. In other words, if components and relationships other than the elements recited in the claims could be used, then the doctrine of inherency does not apply.

In this case, the relevant claims recite that a user interface comprises an alphanumeric keypad. Alphanumeric keypads are not inherent to user interfaces. User interfaces exist that do not have alphanumeric keypads. For example, a mouse is a type of user interface that might not have alphanumeric keypads. It may be possible that a user interface includes alphanumeric

keypads, however, this is not the standard for the inherency doctrine. Mere probabilities or possibilities are not supported by the inherency doctrine. For the inherency doctrine to apply, every user interface must necessarily include alphanumeric keypads. This is not true. Thus, the inherency doctrine has been misapplied.

For at least the above reasons, it is respectfully submitted that the rejections based on the inherency doctrine should have been withdrawn.

With respect to claims 47, 57, 70, 75, 80 and 85, the Examiner alleges that “[i]t would have been obvious to specifically include a wireless modules, such as wireless RF units or transceivers with associated peripheral circuitry, in the invention of Trahan, since many mobile communication devices (in the art) utilizes wireless transceivers or RF units.” Office Action at page 7.

The Examiner then takes Official Notice that, as alleged, Schaefer teaches a communication device 14 removably attached to two-way radio.

Applicants respectfully challenge the conclusory assertions made in the Office Action and the inappropriateness of taking Official Notice. In addition, Applicants challenges the technical line of reasoning underlying the Examiner’s decision to take Official Notice. The Office Action at page 7 states that “[i]t would have been obvious ... since many mobile communication devices (in the art) utilizes wireless transceivers or RF units”.

However, the relevant dependent claims recite that the new function comprises a wireless communication capability. The Examiner has presented a technical inconsistency in the Examiner’s line of reasoning. Recall, that with respect to the independent claims 44, 54, 67, 72, 77 and 82, the Examiner alleged that the new function was related to the insertion of a SIM card into a card reader. See, e.g., Office Action page 4. While still maintaining this interpretation, the Examiner is now alleging that the new function relates to attaching an RF module.

The Examiner's allegations with respect to the independent claim is different from the allegation with respect to dependent claim even though the element "new function" is the same in the independent claim and the dependent claim.

Furthermore, Schaefer disagrees with the motivation provided by the Examiner that the RF module is removable attached so as to add new functionality as alleged by the Examiner with respect to the relevant dependent claims. In fact, according to the Schaefer, the motivation behind a removable RF module is easier maintenance: "RF module is easily removable from the control systems module by means of a small number of screws and/or bolts, thus improving maintainability of the radio". Schaefer at col. 2, lines 58-61.

Applicants not only challenge the technical line of reasoning underlying the Examiner's taking of Official Notice, but Applicants also challenge what is allegedly well known or obvious. In particular, as alleged, neither Schaefer nor Trahan, individually or combined, teaches that the new function comprises a wireless communication capability in which the new function is further defined in the respective independent claim (see, e.g., claims 44, 54, 67, 72, 77 and 82). Given the context of the relationship of "new function" between the dependent and independent claims, Applicants respectfully submit that the elements recited in dependent claims 47, 57, 70, 75, 80 and 85 are not well known or obvious. Furthermore, since the Examiner's technical line of reasoning underlying the Examiner's decision to take Official Notice is not "clear" and is not "unmistakable", Applicants respectfully submit that the Examiner improperly took Official Notice. See, e.g., M.P.E.P. § 2144.03.

Applicants do not necessarily agree or disagree with the Examiner's characterization of the documents made of record, either alone or in combination, or the Examiner's characterization of recited claim elements. Furthermore, Applicants respectfully reserve the right to argue the characterization of the documents of record, either alone or in combination, to argue what is allegedly well known, allegedly obvious or allegedly disclosed, or the characterization of the

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recited claim elements should that need arise in the future.

With respect to the present application, Applicants hereby rescind any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer of claim scope, if any, and the alleged prior art that it was made to allegedly avoid, may need to be revisited. Nor should a disclaimer of claim scope, if any, in the present application be read back into any predecessor or related application.

In view of at least the foregoing, it is respectfully submitted that the present application is in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, to charge any fee deficiencies or to credit any overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: January 31, 2008

Respectfully submitted,

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